

REMARKS/ARGUMENTS

Claims 1-5, 39-41, 43-48 and 51 have been canceled without prejudice for re-presentation of their subject matter in a continuing application.

Claims 6, 7, 10-12, 14, 15, 18-20, 23, 24, 27-29, 32, 34, 36, 38, 42, and 49-50 have been revised to better tailor the claims to the election below and currently contemplated commercial embodiments of the invention. The revisions are made for business reasons unrelated to any position set forth in the Restriction Requirement.

Support for the revisions to the claims is provided throughout the specification as filed.

New claims 52-57 are supported at least by claims 49 and 50. New claims 58, 59, and 60 are supported at least by claims 22, 7, and 9, respectively. Similarly, new claims 61-63 are supported at least by claim 38, while new claims 64-66 are supported by at least claim 42.

No new matter has been introduced, and entry of the revised claims is respectfully requested.

RESPONSE TO RESTRICTION

Reconsideration and modification or withdrawal of the Restriction Requirement is respectfully requested in light of the following remarks.

The Restriction Requirement sets forth the following Groups:

Group I, claims 1-5 and 45-48;

Groups II-V, claims 7-11, 14-19, 22, 32-35, 38-43, and 49-50 with detection of nucleic acids;

Groups VI-IX, claims 7-9, 12-13, 14-17, 20-22, 32-34, and 36-41 with detection of polypeptides;

Groups X-XIII, claims 24-28 and 31 with detection of nucleic acids; and

Groups XIII-XVII, claims 24-26 and 29-31 with detection of polypeptides.

Claims 6 and 23 are alleged to link Groups II-IX and X-XVII, respectively.

The Restriction Requirement further states that “the restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 6 and 23. Upon the indication of allowability of the linking claim(s), the restriction as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability...” (see page 13 of the Restriction Requirement).

Applicants understand the above to indicate that should one of Groups II-IX or one of Groups X-XVII be elected, linking claims 6 or 23, respectively will be examined with the elected Group and should the linking claim be found allowable, the claims of the remaining Groups will be rejoined.

Presence of Genus Claims

Even if the above understanding is correct, Applicants respectfully traverse the assertion of Groups II-IX, and Groups X-XVII, as two clusters of separate inventions that are “linked inventions.” Applicants point out that the alleged separation of the claims into each of the two clusters appears to reflect a failure to recognize that claims 6, 14, 23, 32, 49 and 50 (as well as claims 8, 16, 25, and 33) are each a genus claim, for example as reflected in claims 7, 15, and 24 as well as two representative species: assays via nucleic acid or polypeptide detection. The alleged separation of the Groups in each cluster is separation of the genus into the species of claims 7, 15, and 24 as well as the two representative species, *but without recognition of the genus claims*.

Recognition of the presence of genus claims is important because Applicants regard the subject matter of the genus claims as their invention. Any attempt to restrict the genus to be merely species thereof would deny Applicants the ability to seek claims directed to what they regard as the invention. See *In re Weber* (580 F.2d 455, 198 USPQ 328 (CCPA 1978)) and *In re Haas* (580 F.2d 461, 198 USPQ 334 (CCPA 1978)), and the discussion at MPEP 803.02. These decisions clearly set forth that a restriction requirement cannot be used to divide a single claim, such as a genus claim. Therefore, and by way of example, claims 7-11, 14-19, 22, 32-35, and 38-43 as well as 24-31 cannot be divided by restriction.

In light of the above arguments, and even if the understanding of the prosecution of “linked inventions” indicated above is correct, Applicants respectfully request reconsideration and modification of the instant Restriction Requirement at least in favor of one group in place of asserted Groups II-IX and a second group in place of asserted Groups X-XVII.

Presence of Subject Matter Related as Combination/Subcombination

Additionally, Applicants respectfully traverse the assertion of Groups II-IX, and Groups X-XVII, as two clusters of separate inventions. The subject matter of Groups X-XVII is related to the subject matter of Groups II-IX as a combination is to a subcombination. This inter-relationship between the subject matter thus makes the claims of the two clusters related not in terms of “unrelated” processes as alleged in the Restriction Requirement, but rather one of combination (claims 23 and those in Groups X-XVII) and subcombination (claims 6 and those in Groups II-IX).

To emphasize the relationships of combination and subcombination, claim 23 has been revised to incorporate the features of claim 6. The subject matter of claims 23 and those in Groups X-XVII are thus a “combination” to which the subject matter of claims 6 and those in Groups II-XVII are subcombinations.

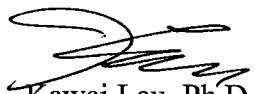
Given the combination/subcombination relationship of the subject matter featured in the claims as described above, Applicants respectfully traverse the assertion of Restriction among the claims of alleged Groups II-IX and Groups X-XVII. The standards at MPEP 806.05(c) for restriction between inventions that are related as combination and subcombination must be met to support an assertion of a Restriction Requirement. Those standards require the demonstration of two-way distinctness, which has not been presented in the instant case. In the absence of such a demonstration, the alleged Restriction between the pending claims is misplaced and should be withdrawn.

In light of the above arguments regarding the presence of genus claims and a combination/subcombination relationship, Applicants respectfully request reconsideration and modification of the instant Restriction Requirement in favor of one group comprising all the claims now pending.

In the event that the Restriction Requirement is maintained, Applicants elect Group III, with traverse for the reasons provided above. By way of confirmation, the elected Group is directed to assessment of expression levels of a combination of HoxB13 and IL17BR by nucleic acid means and relative to treatment with an SERM. New claims 52, 53, 62, and 65 are believed to correspond to this elected group.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6151.

Respectfully submitted,


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